



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/531,572

04/18/2005

Takashi Kenmoku

03500.017652.

2325

5514

7590

06/17/2009

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HANLEY, SUSAN MARIE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

06/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,572	Applicant(s) KENMOKU ET AL.	
	Examiner SUSAN HANLEY	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 23-35 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The lack of unity made on 10/9/07 was based on Yano et al. (EP 1,340,776; cited in the IDS filed 4/18/05) is withdrawn in light of the perfection of the foreign priority claim to JP 2002-309786. Hence, there is no lack of unity and all of the claims were rejoined in the last Office action.

Claims 21-37 are under examination.

Biological Deposit

Regarding the deposit of biological material for the microorganisms belonging to the strains *Pseudomonas cichorii* YN2 (FERM BP-7375), *Pseudomonas cichorii*, H45 (FERM BP-7374) and *Pseudomonas jessenii* P161 (FERM BP-7376), Applicant states that the IFW file for US Application No. 10603996, now patent US 7,078,200, contains the papers (October 5, 2004 submission) pertaining to the deposit and availability of the microorganisms recited supra and in instant claim 25. The information in the October 24, 2004 submission and the statement by a person in position to assert that the deposit was made under the Budapest Treaty and that all restriction to access to the public be irrevocably withdrawn upon the granting patent US 7,078,200 satisfies this issue in the instant application. Accordingly, said deposit is considered to establish that the essential biological material is both known and readily available during the term and under the condition of the deposit set forth in US patent US 7,078,200.

Double Patenting

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,911,520.

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,908,721.

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,645,743.

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,649,380.

Applicant argues that the filing of a terminal disclaimer at this time is premature and expensive.

Applicant's argument is not directed to the factual basis of the rejection and is, therefore, non-persuasive. The rejections stand for the reasons of record.

New Grounds of Rejection
Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 and 25-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1651

Claim 23 is rejected because it is confusing. It is unclear if structure (5) is a second monomer that can comprise the polyhydroxyalkanoate (as an alternative to structure (4) or if it is part of the definition of R. If the former is the case, then it is suggested that the phrase “and R comprises a residue having either a phenyl structure or a thienyl structure,” be deleted since R is defined later in the claim. Similarly, if the former is the case, it is suggested that the phrase “formula (5),” be changed to -- formula (5); --.

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: contacting a monomer of structure (2) or (3) with the reaction mixture of claim 25.

Claim 28 is rejected because it is extremely confusing. It is unclear if structure (5) is a second monomer that can comprise the polyhydroxyalkanoate (as an alternative to structure (4) or if it is part of the definition of R. If the former is the case, then it is suggested that the phrase “and R comprises a residue having either a phenyl structure or a thienyl structure,” be deleted since R is defined later in the claim. Similarly, if the former is the case, it is suggested that the phrase “formula (5),” be changed to -- formula (5); --.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: contacting a monomer of

Art Unit: 1651

structure (20) or (21) with the reaction mixture of claim 25. Otherwise the purpose of the monomers in the claims is unclear.

Claim 25 is rejected because the structure of claim (10) is a polyhydroxyalkanoic acid, not a polyhydroxyalkanoate, as recited two lines before the structure of formula (19).

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a medium is necessary for a biochemical reaction to take place.

Claim 28 is rejected because lines 28-30 (beginning with "under a condition which . . . by the chemical formula (21)") is extremely confusing. Its purpose and wording are so unclear as to make the phrase incomprehensible.

Claims 27 and 29-35 are rejected because they are dependent claims that do not overcome the deficiencies of the rejected independent claim from which they depend.

Claims Suggestions

In all cases where a variable "can be", it is suggested that "can be replaced by -- is - See claims 21, 22, 23, 25, 26 and 28.

In claim 25, it is suggested that lines be changed to -- the method comprising contacting a microorganism of one of more strains . . . (FERM BP-7376), in a medium with a polyhydroxyalkanoic acid --.

It is suggested that claims 29 and 30 be cancelled if the suggestion for claim 25 is adopted (including the limitation of a medium in claim 25 since a medium is necessary for the reaction to take place).

In claim 28, it is suggested that line 15 because to the following" -- shown in chemical formula (5), comprising contacting said microorganism with --.

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Hanley/
Examiner, Art Unit 1651

/Sandra Saucier/
Primary Examiner, Art Unit 1651